

REMARKS/ARUGMENTS

This communication is in response to the Final Office Action dated October 23, 2006. Claims 1-6 remain pending in this application with claim 1 being the only independent claim. Reconsideration in view of the amendments and remarks presented herein is respectfully requested.

Traverse Finality of Outstanding Office Action

On a preliminary note, Applicants respectfully traverse the finality of the outstanding Office Action. In the outstanding Office Action the Examiner has asserted new grounds for rejection of claims 1-6 and stated that Applicants' amendments to the claims necessitated the change. Applicants respectfully disagree and draw the Examiner's attention to claim 1 rejected on new grounds despite being amended only to correct a typographical error in the term "from" to "form". Even the Examiner herself on page 2 of the May 4, 2005 Office Action acknowledged that this was merely a typographical error and stated the correct term thereby confirming that the proper claim interpretation was understood by the Examiner. Accordingly, correction of this typographical error clearly did not necessitate the new grounds for rejection of claim 1. Applicants therefore request that the Examiner withdraw the finality of the outstanding Office Action.

Traverse Prior Art Rejections

Claims 1-6 are rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,858,012 (Yamaki et al.) in view of JP 09-271488 (Iwao et al.).

Applicants respectfully traverse the prior art rejection of claims 1-6 for the reasons discussed below.

Independent Claim 1

In the outstanding Office Action the Examiner acknowledges that Yamaki et al. fails to disclose or suggest that "said rear elastic area is broader than said front elastic area with respect to the longitudinal direction of said absorbent article body". The Examiner maintains that Iwao et al. in combination with Yamaki et al. teaches this missing limitation.

"Iwao et al express the desire to provide a disposable absorbent garment which fits tightly and well to the hips of a wearing person (abstr.). As seen in Figures 1, 2 and 4, Iwao et al teaches a disposable absorbent article with broader elastic area (W1) provided with a greater number of elastic members than less broad elastic area (W2)." (October 23, 2006 Final Office Action: Page 3, lines 13-16)

Applicants agree that Iwao et al. teaches a front elastic area (W1) that is broader than a rear elastic area (W2). However, claim 1 calls for just the opposite. That is, claim 1 requires that the "rear elastic area is broader than said front elastic area with respect to the longitudinal direction of said absorbent article body. Accordingly, Applicants assert that the Examiner has failed to establish a *prima facie* case of obviousness.

In addition, Applicants wish to address the Examiner's remarks in the "Response to Arguments" section of the outstanding Office Action in which the Examiner states that Yamaki et al. alone teaches a broader rear area.

"Yamaki discloses c.2, ll. 47-49, the front and rear waist regions 6,7 are additionally provided with a plurality of second elastic members 23. These second elastic members 23 each have a relatively large width of 3.about 10 mm and are stretchable circumferentially of the waist regions and bonded in their stretched conditions to an inner surface of at least one of the topsheet 17 and the backsheet 18. As shown, an upper end 27 of the rear waist region 7 sufficiently extends upward beyond the elastic members 21 to overlie an upper end 26 of the front waist region 6." (October 23, 2006 Final Office Action: Page 7, line 18 through Page 8, line 4)

This passage in question from Yamaki et al. merely discloses (Figure 1) that the rear waist region 7 is broader than the front waist region 6. However, the claim expressly states that the "rear elastic area" (formed by the rear waist elastic members, as called for in claim 1) is broader than the "front elastic area" (formed by the front waist elastic members, as called for in claim 1) with respect to the longitudinal direction of said absorbent body. Yamaki et al. is silent regarding the width in the longitudinal direction of either the "rear elastic area" (as formed by the rear waist elastic members 23) or the "front elastic area" (as formed by the front waist elastic members 23), much less, a comparison of one relative to the other, as found in claim 1.

Accordingly Applicants assert that neither Yamaki et al. alone, or in combination with Iwao et al, render independent claim 1 unpatentable.

Dependent Claim 3

Claim 3 provides "the distance between said waist opening elastic members and the portion of said rear waist elastic members closest to said waist opening elastic members is approximately equal to said distance between each rear waist elastic member and its adjacent rear waist elastic member". In rejecting claim 3, the Examiner states " With respect to claim 3, as seen in Figure 2, Yamaki et al. disclose the distance between the waist opening elastic members (21) and the portion of the rear waist elastic members (23) is approximately equal to the distance between each rear waist elastic member (23) and its adjacent rear waist elastic member (23)." (October 23, 2006 Final Office Action; p. 4, ll. 1-4)

Applicants respectfully traverse the Examiner's rejection. Figure 2 of Yamaki et al. is merely a plan view of the diaper unfolded back and forth from its state shown in Figure 1. In Figure 1, the distance between the elastic member 21 and the portion of the elastic members 23 in the rear region 7 is greater (approximately 2 times greater) than the distance between each elastic member 23 and its adjacent elastic member 23 in the rear waist region 7. Applicants submit that the Examiner has improperly relied on the scale of the drawings alone, absent any disclosure in the specification, to teach this claimed limitation. MPEP §2125 provides "When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. '[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.')."

Yamaki et al. fails to indicate that the drawings are drawn to scale. Accordingly, any measurements based on the drawings alone, especially in light of the inconsistency in the scale of related figures in the drawings, is not a proper basis for rejecting the claimed invention.

Applicants also wish to address the Examiner's comments in the Response to Arguments section wherein she states that "Applicants' arguments with regard to dependent claims 2-6 have been fully considered but are not persuasive as Applicants' arguments depend entirely on Applicants' arguments regarding the rejection of claim 1, which have been addressed *surpa*."

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(October 23, 2006 Final Office Action: Page 8, lines 13-15) Despite the dependency of dependent claims 2-6 from independent claim 1, the arguments traversing these prior art rejections submitted herein and in the previous August 2, 2006 Amendment are independent of those presented with respect to claim 1. Accordingly, should the rejections not be overcome by the arguments presented herein, Applicants request that the Examiner state her reasoning with respect to this and the other dependent claims.

Dependent Claims 4-6

As best understood by Applicant's representative, the Examiner in the outstanding Office Action appears to be posing multiple arguments with respect to dependent claims 4-6. On the one hand the Examiner maintains that the limitations found in dependent claims 4-6 are expressly taught by Yamaki et al.

Claim 4 states that the "absorbent core is arranged so as not to overlap said front elastic area while overlapping at least a part of said rear elastic area". In the outstanding Office Action the Examiner asserts that in Yamaki et al. "the absorbent core (38) is arranged so as not to overlap the front waist elastic area (26) while not overlapping at least a part of the rear elastic area (26) (col. 2, ll. 35-65; col. 1, ll. 40-51; abstract, penultimate lines)." (October 23, 2006 Final Office Action; Page 4, lines 9-11)

Similarly, claims 5 and 6 each provide "said absorbent core is arranged so as not to overlap said rear elastic area while overlapping at least a part of said front elastic area". In the outstanding Office Action the Examiner states that Yamaki et al. teaches that "the absorbent core (38) is arranged so as not to overlap the rear elastic area (26) while overlapping at least a part of the front elastic area (27)." (October 23, 2006 Final Office Action: Page 5, lines 10-11)

Applicants respectfully disagree with the Examiner's interpretation of the claimed front elastic area reading on front end (26) in Figure 2 of Yamaki et al. Claim 1, from which claims 4-6 each depends, expressly states "said rear waist elastic members form a rear elastic area in said rear waist region" while "said front waist elastic members form a front elastic area in said front waist region". Clearly, in Figure 2 of Yamaki et al. the absorbent 2 including absorbent core 38 overlaps front and rear elastic members 23 which define the front elastic area and a rear elastic area, respectively. Accordingly, Yamaki et al. fails to disclose or suggest that the absorbent core

is arranged so as not to overlap the front elastic area (as found in claim 4) or the rear elastic area (as found in claims 5 and 6).

On the other hand the Examiner appears to assert in the alternative that with respect to claims 4-6 the combination of Yamaki et al. and Iwao et al. fail to teach the location of the core in either the front or the rear of the diaper. Nevertheless, the Examiner maintains that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the absorbent core in the front or rear as is known in the diaper art since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, USPQ 70." (October 23, 2006 Final Office Action: Page 6, lines 1-7)

Applicants disagree with the Examiner's interpretation of the rule of law from *In re Japikse*. MPEP §2144.04 (VI)(C) entitled "Rearrangement of Parts" cites *In re Japikse* stating that "Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held obvious because shifting the position of the starting switch would not have modified the operation of the device." (emphasis added) Thus, *In re Japikse* does not provide a per se ruling as adopted by the Examiner that any rearrangement of parts taught by a prior art reference is an obvious unpatentable modification. Instead, *In re Japikse* stands for the proposition that rearrangement of the position of a part relative to the teaching of a prior art reference renders the claim obvious only if such rearrangement would not have modified the operation of the device. Arrangement of the absorbent core so as not to overlap the rear elastic area while overlapping at least a part of the front elastic area, as found in claim 1, modifies the functionality of the diaper as expressly disclosed in the specification.

"The absorbent core 4 is provided so as to partially overlap the rear elastic area 25. Therefore, even if the absorbent core 4 is positioned so as to extend into the rear waist region 13 and the front waist region 15 to the same extent, the absorbent core 4 closely fits at the front waist side of the wearer. In other words, the embodiment shown in Fig. 6 prevents leakage without the absorbent core 4 extending into the rear waist region 13 any further than necessary." (Specification: Page 21, lines 12-20) (Similar language with respect to the partial overlap of the absorbent core in the front elastic area is disclosed on Page 23, lines 4-12)

Applicants therefore submit that as expressly taught in the specification of the present application arrangement of the absorbent core, as claimed, modifies the operation of the device. Accordingly, Yamaki et al. fails to render the claimed arrangement of the absorbent core obvious.

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MPEP section §2144.04 (VI)C further states "However, 'The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.' *Ex part Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)." (emphasis added) In the present case, Yamaki et al. fails to provide a motivation or reason in the prior art reference, absent improper use of the specification of the present invention as a template, for arrangement of the absorbent core as claimed. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

For the foregoing reasons Applicants submit that independent claims 1-6 are patentable over the art of record. Applicants submit that the application is now in condition for allowance and passage to issuance is requested.

If any additional fees or charges are required at this time in connection with the application, authorization is hereby given to charge our Patent and Trademark Office Deposit Account No. 503462.

Respectfully submitted,



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